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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Arno D. Bruns

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EXAMINER

PLUCINSKI, JAMISUE A

ART UNIT

PAPER NUMBER

3629

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/765,089	Applicant(s) BRUNS, ARNO D.	
	Examiner JAMISUE A. PLUCINSKI	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27, 29 and 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27, 29 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

a. Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-11, 23, 25-27, 29 and 30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

3. The first step in determining whether a claim recites patent eligible subject matter is to determine whether the claim falls within one of the four statutory categories of invention recited in 35 USC 101: process, machine, manufacture and composition of matter. The latter three categories define "things" or "products", while a "process" consists of a series of steps or acts to be performed.

4. In Claims 1-11, 25-27, 29 and 30, the claims are drawn to a method. For purposes of 101, a "process" has been given a specialized, limited meaning by the courts. Based on *In re Bilski* (Federal Circuit 2007-1130), the court outlined a test used to determine whether a method satisfies 35 USC 101, is a machine-or-transformation test. *In re Bilski* states "the machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfies 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. See *Benson*, 409 U.S. at 70. Certain considerations are applicable to analysis under either branch. First as illustrated by *Benson* and discussed below, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. See *Benson*, 409 U.S. at 71-72. Second, the involvement of the

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machine or transformation in the claimed process must not merely be insignificant extra-solution activity. See *Flook*, 437 US at 590. Claims 60-65 are drawn to a method using a computer for return processing, however the computer is not used in the body of the claim in any way, therefore can serve as a display which instructs a user to perform certain steps. In the present claims, there is not a particular machine being recited in the claims, (i.e. none of the critical steps of the claims are being performed by or involve any particular machine). Therefore fails the machine-or-transformation test.

5. With respect to Claim 13: the preamble of the claim recites the use of a “computer readable medium containing instructions to configure data processor to perform a method for...” The applicant has claimed the computer readable medium however have never stated that the instructions are computer executable instructions, or when the instructions are executed on a computer it causes the data processor to perform the method”, therefore the instructions on the claim, can simply be a list of things a user would need to do to perform the method. Therefore causing the instructions to be non-functional, and therefore not drawn to statutory subject matter.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 1-4, 6, 8-15, 17, 19-25, 29, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (US 2004/0225507) in view of Wilson et al. (US 2002/0133387).

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8. With respect to Claims 1, 12, 23, 24, 25 and 30: Smith discloses the use of a method, system and a computer readable medium with instructions to configure a processor to perform functions for planning a delivery of at least one good comprising:

- a. Receiving a sales order with a description of a good, the location of the good and requested delivery date (Paragraph 0017);
- b. selecting a source location for the good (Paragraph 0020, Smith discloses determining which supplier is associated with the order, therefore the examiner considers this to be selecting the source location of the good, and discloses) and an origin of the good/supplier (Paragraph 0030);
- c. determining a set of trips based on a set of geographic routes, transportation service provider information, and scheduling information (Paragraphs 0024 and 0025, ship schedules from each supplier are received, in order to determine the delivery date. The examiner considers this to be a set of trips);
- d. selecting a trip from the set of trips based on a set of criteria (Paragraph 0024); and
- e. scheduling the trip such that the good is scheduled to be delivered from the source location to the destination location substantially close to the requested delivery date (Paragraph 0004 and 0034).

2. Smith discloses selecting a source location for the good which includes the supplier and the good origin, however discloses it is based on the date the goods leave the source, not the availability date of the good at the source location, and does not disclose it is determined independently of the requested delivery date, and does not specifically state the scheduling of the

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trip is based on the requested delivery date. Wilson discloses a supply chain management system which discloses then if the item is available then it chooses the source location based on the availability and schedules the delivery to ensure the requested delivery date is met (See Figure 5A with corresponding detailed description). It would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify Smith to include selecting the source location based on availability in order to allow for the warehouse that is the best equipped to handle an order according to the customer's wants and needs to be used, in order to increase customer satisfaction and to ensure customer's needs are being met (See Wilson, Pages 1 and 2).

3. With respect to Claims 2 and 13: Smith discloses determining a set of trips comprises selecting one or more geographic routes from the set of geographic routes (See Table 1, Page 3).

4. With respect to Claims 3 and 14: Smith discloses selecting one or more geographical routes comprises restricting the set of geographical routes based on a geographical classification for the source location and the destination location (Paragraph 0026, Smith discloses using zones, which the examiner consider to be geographic classification).

5. With respect to Claims 4 and 15: Smith discloses determining a set of trips comprises selecting a transportation service provider for each geographic route (Paragraph 0024).

6. With respect to Claims 6 and 17: Smith discloses the set of criteria comprises at least one criterion representative of closeness of a trip delivery date to the requested delivery date (Paragraph 0034).

7. With respect to Claims 8-10 and 19-21: See Philippe, Figure 5A with corresponding detailed description.

8. With respect to Claims 11 and 22: See Smith Paragraph 0034 and 0035.

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9. With respect to Claim 29: See Smith Paragraph 0037.
10. With respect to Claim 27: Smith and Wilson disclose the use of selecting a delivery date, however fails to disclose the customer indicating it is a rush order and scheduling for the rush order. The examiner is taking official notice that the use of Rush orders are well known to one of ordinary skill in the art. This is done when ordering same day service, or rush print jobs, or even when ordering express delivery for commercial carriers, and the rush order delivery date is scheduled there with. If the order is a rush order, Smith discloses planning for order, therefore obvious that Smith would plan for rush order. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify Smith and Wilson, to have the user indicate the order is a rush order and schedule accordingly.
11. Claims 5, 7, 16, 18 and 26 rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. and Wilson et al. in further view of Arunapuram et al. (US 2002/0019759).
12. Smith discloses the use of trip schedules, however fails to disclose eliminating the trip schedules or selecting a trip based on dangerous goods or cost information. Arunapuram discloses the use of shipping orders, where a set of trips for a shipping order are set, and a trip is selected based on things such as cost and whether the items are hazardous material (See Arunapuram, abstract and Paragraph 0055). It would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify Smith, to have the optimal trip selected, based on criteria, such as hazardous material and cost, as disclosed by Arunapuram, in order to provide an optimum solution based on the customer's needs (See Arunapuram, abstract and Pages 1 and 7).

Response to Arguments

13. Applicant's arguments with respect to claims 1-27, 29 and 30 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Aram (US 2007/0072986) discloses the use of an electronic procurement system, Cassidy et al. (7,107,226), Djupsjobackol et al. (6,954,735) and Weber et al. (US 2002/0156663) discloses shipping system when determines availability dates.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMISUE A. PLUCINSKI whose telephone number is (571)272-6811. The examiner can normally be reached on M-Th (5:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jamisue A. Plucinski/
Primary Examiner, Art Unit 3629